

REMARKS

Applicants concurrently file herewith a Request for Continued Examination, a Petition for Extension of Time for a three-month extension of time, and the fees associated therewith.

Claims 1 and 2 are all of the claims presently pending the application. Claims 1 and 2 have been amended to more particularly define the claimed invention. Claim 5 has been canceled without prejudice or disclaimer (the subject of which has been incorporated into claim 1).

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1, 2 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as being unpatentable over, Japanese Patent 2001-131712 (hereinafter “JP ‘712”). Claims 1, 2 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over, Tanaka et al. (U.S. Patent No. 6,086,686) (hereinafter “Tanaka ‘686”) or Tanaka et al. (U.S. Patent No. 5,988,042) (hereinafter “Tanaka ‘042”).

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention of exemplary claim 1, provides a bearing part including damping steel including from 0.09% to 0.15% by weight of N (e.g., see Application at page 5, lines 11-20). This combination of features is important for improving the dampability of bearing parts (see Application at page 3, lines 2-4).

II. THE PRIOR ART REFERENCES

A. The JP '712 Reference

The Examiner alleges that JP '712 teaches the claimed invention of claims 1, 2 and 5. Applicants submit, however, that JP '712 does not teach or suggest each and every feature of the claimed invention.

That is, JP '712 does not teach or suggest a damping steel including "*from 0.09% to 0.15% by weight of N*", as recited in claim 1.

The Examiner attempts to rely on Table 1 and paragraph 17 of JP '712 to support her allegation. The Examiner, however, is clearly incorrect.

That is, nowhere in this table or this passage (nor anywhere else for that matter) does JP '712 teach or suggest a damping steel including from 0.09% to 0.15% by weight of N. Indeed, the Examiner does not even allege that JP '712 teaches or suggests this feature.

JP '712 does not teach a specific steel composition including from 0.09% to 0.15% by weight of N. Indeed, JP '712 merely teaches examples of steel compositions including 800 ppm, 1400 ppm and 2000 ppm by weight N. Applicants point out that "[A]nticipation under the § 102 can be found only when the reference discloses exactly what is claimed" (see M.P.E.P. § 2131.03). That is, prior art that teaches a value or range that is very close to, but does not overlap or touch, the claim range does not anticipate the claimed range.

The exemplary amounts of N taught by JP '712 do not overlap or touch the value of N recited in the claimed invention. Therefore, Applicants submit that JP '712 does not teach or suggest (nor make obvious) each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

B. The Tanaka '686 Reference

The Examiner alleges that Tanaka '686 teaches the claimed invention of claims 1, 2 and 5. Applicants submit, however, that Tanaka '686 does not teach or suggest each and every feature of the claimed invention.

That is, Tanaka '686 does not teach or suggest a damping steel including "*from 0.09% to 0.15% by weight of N*", as recited in claim 1.

The Examiner attempts to rely on Tables 1 and 2 of Tanaka '686 to support her allegation. The Examiner, however, is clearly incorrect.

That is, nowhere in this table or this passage (nor anywhere else for that matter) does Tanaka '686 teach or suggest damping steel including from 0.09% to 0.15% by weight of N. Indeed, Tanaka '686 merely teaches a broader range of 0.05% to 0.19% by weight N.

"When the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with 'sufficient specificity to constitute an anticipation under the statute'. What constitutes a 'sufficient specificity' is fact dependent. If the claims are directed to a narrow range, the references teach a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed to with 'sufficient specificity' to constitute an anticipation of the claims" (see M.P.E.P. § 2131.03).

The claimed invention recites a specific, narrow weight percentage of N (e.g., from 0.09% to 0.15%), which falls within a broader range taught by Tanaka '686.

Applicants submit that the narrow weight percentage of N recited in exemplary claim 1 is clearly important. That is, the Application discloses that the specific percentage of N recited in claim 1 is important for lowering dampability. Indeed, as conceded by the

Examiner, the comparative test examples disclosed in Table 1 on page 8 of the Application demonstrates that importance of the claimed weight percentage of N (see Office Action dated December 7, 2005 at page 5, numbered paragraph 15).

This feature is clearly not recognized by Tanaka '686. Indeed, Tanaka '686 merely teaches that including more than 0.2 wt% of N results in increased production costs. Thus, the Application teaches the importance of the narrow weight percentage of N, recited in exemplary claim 1, which is not recognized by Tanaka '686.

Therefore, Applicants submit that Tanaka '686 does not teach or suggest (nor make obvious) each and every feature of the claimed invention including the narrower range for N. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

C. The Tanaka '042 Reference

The Examiner alleges that Tanaka '042 teaches the claimed invention of claims 1, 2 and 5. Applicants submit, however, that Tanaka '042 does not teach or suggest each and every feature of the claimed invention.

That is, Tanaka '042 does not teach or suggest a damping steel including "*from 0.09% to 0.15% by weight of N*", as recited in claim 1.

The Examiner attempts to rely on Tables 1 and 2 of Tanaka '042 to support her allegation. The Examiner, however, is clearly incorrect.

That is, nowhere in this table or this passage (nor anywhere else for that matter) does Tanaka '042 teach or suggest damping steel including from 0.09% to 0.15% by weight of N. Indeed, Tanaka '042 merely teaches a broader range of 0.07% to 0.19% by weight N.

"When the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed

subject matter must be disclosed in the reference with ‘sufficient specificity to constitute an anticipation under the statute’. What constitutes a ‘sufficient specificity’ is fact dependent. If the claims are directed to a narrow range, the references teach a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed to with ‘sufficient specificity’ to constitute an anticipation of the claims” (see M.P.E.P. § 2131.03).

The claimed invention recites a specific, narrow weight percentage of N (e.g., from 0.09% to 0.15%), which falls within a broader range taught by Tanaka ‘042.

Applicants submit that the narrow weight percentage of N recited in exemplary claim 1 is clearly important. That is, the Application discloses that the specific percentage of N recited in claim 1 is important for lowering dampability. Indeed, as conceded by the Examiner, the comparative test examples disclosed in Table 1 on page 8 of the Application demonstrates that importance of the claimed weight percentage of N (see Office Action dated December 7, 2005 at page 5, numbered paragraph 15).

This feature is clearly not recognized by Tanaka ‘042. Indeed, Tanaka ‘042 merely teaches that including more than 0.2 wt% of N results in increased production costs. Thus, the Application teaches the importance of the narrow weight percentage of N, recited in exemplary claim 1, which is not recognized by Tanaka ‘042.

Therefore, Applicants submit that Tanaka ‘042 does not teach or suggest (nor make obvious) each and every feature of the claimed invention including the narrower range for N. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicants submit that claims 1 and 2, all the claims presently pending in the application, are patentably distinct over the prior art of record and

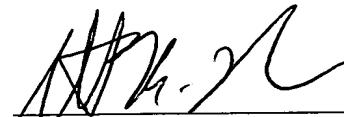
are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: June 6, 2006



Scott M. Tulino, Esq.
Registration No. 48,317

Sean M. McGinn, Esq.
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254